

**This Opinion is Not a
Precedent of the TTAB**

Mailed: April 11, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board
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In re Love And Pieces LLC
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Serial No. 90163005
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Heidi Tandy of Berger Singerman LLP,
for Love And Pieces LLC.

Ronald DelGizzi, Trademark Examining Attorney, Law Office 107,
J. Leslie Bishop, Managing Attorney.

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Before Shaw, Lynch, and Lebow,
Administrative Trademark Judges.

Opinion by Lynch, Administrative Trademark Judge:

I. Background and Evidentiary Issue

Love And Pieces LLC (“Applicant”) seeks to register on the Principal Register the mark BOAT ERASERS in standard characters for a “Cleaning Sponge to remove scuffs and marks” in International Class 21.¹

¹ Application Serial No. 90163005 was filed September 7, 2020, based on an allegation of use of in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a). Applicant amended the application on January 17, 2019 to seek registration on the Supplemental Register.

The Examining Attorney refused registration of Applicant's mark under Section 2(e)(1) of the Trademark Act, 15 U.S.C. § 1052(e)(1), as merely descriptive of the identified goods. After the Examining Attorney made the refusal final, Applicant requested reconsideration and appealed. The Examining Attorney denied the request for reconsideration. The appeal then proceeded, and has been fully briefed.

Applicant attached an exhibit to its Reply Brief and seeks to rely on it as evidence.² Trademark Rule 2.142(d) provides that the record should be complete before an appeal is filed. 37 C.F.R. § 2.142(d). We therefore do not consider Applicant's new evidence, which should have been submitted during prosecution. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) §§ 1203.02(e), 1207.01 (June 2021); TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 710.01(c) (July 2021).

II. Descriptiveness

Section 2(e)(1) of the Trademark Act precludes registration of “a mark which, (1) when used on or in connection with the goods of the applicant is merely descriptive . . . of them.” 15 U.S.C. § 1052(e)(1). “A mark is merely descriptive if it immediately conveys information concerning a feature, quality, or characteristic of the goods or services for which registration is sought.” *Real Foods Pty Ltd. v. Frito-Lay N. Am., Inc.*, 906 F.3d 965, 128 USPQ2d 1370, 1373 (Fed. Cir. 2018) (quoting *In re N.C. Lottery*, 866 F.3d 1363, 123 USPQ2d 1707, 1709 (Fed. Cir. 2017)). “The major reasons for not protecting such [merely descriptive] marks are: (1) to prevent the owner of a

² 9 TTABVue 2-3, 6-9.

mark from inhibiting competition in the sale of particular goods; and (2) to maintain freedom of the public to use the language involved, thus avoiding the possibility of harassing infringement suits by the registrant against others who use the mark when advertising or describing their own products.” *In re Stereotaxis Inc.*, 429 F.3d 1039, 77 USPQ2d 1087, 1090 (Fed. Cir. 2005) (quoting *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978)).

Descriptiveness must be assessed “in relation to the particular goods for which registration is sought, the context in which it is being used, and the possible significance that the term would have to the average purchaser of the goods because of the manner of its use or intended use.” *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1831 (Fed. Cir. 2007) (citing *Abcor Dev.*, 200 USPQ at 218). The descriptiveness analysis concentrates on the identification of goods set forth in the application. See *In re Cordua Rests., Inc.* 823 F.3d 594, 118 USPQ2d 1632, 1636 (Fed. Cir. 2016) (quoting *Octocom Sys., Inc. v. Houston Comput. Servs., Inc.*, 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990)). Evidence that a term is merely descriptive to the relevant purchasing public “may be obtained from any competent source, such as dictionaries, newspapers, or surveys.” *Bayer AG*, 82 USPQ2d at 1831; see also *In re Virtual Indep. Paralegals*, 2019 USPQ2d 111512, *2 (TTAB 2019). “These sources may include Websites, publications, and use ‘in labels, packages, or in advertising material directed to the goods.’” *N.C. Lottery*, 123 USPQ2d at 1710 (citation omitted).

Where a proposed mark, such as this one, consists of multiple words, the mere combination of descriptive words does not necessarily create a nondescriptive

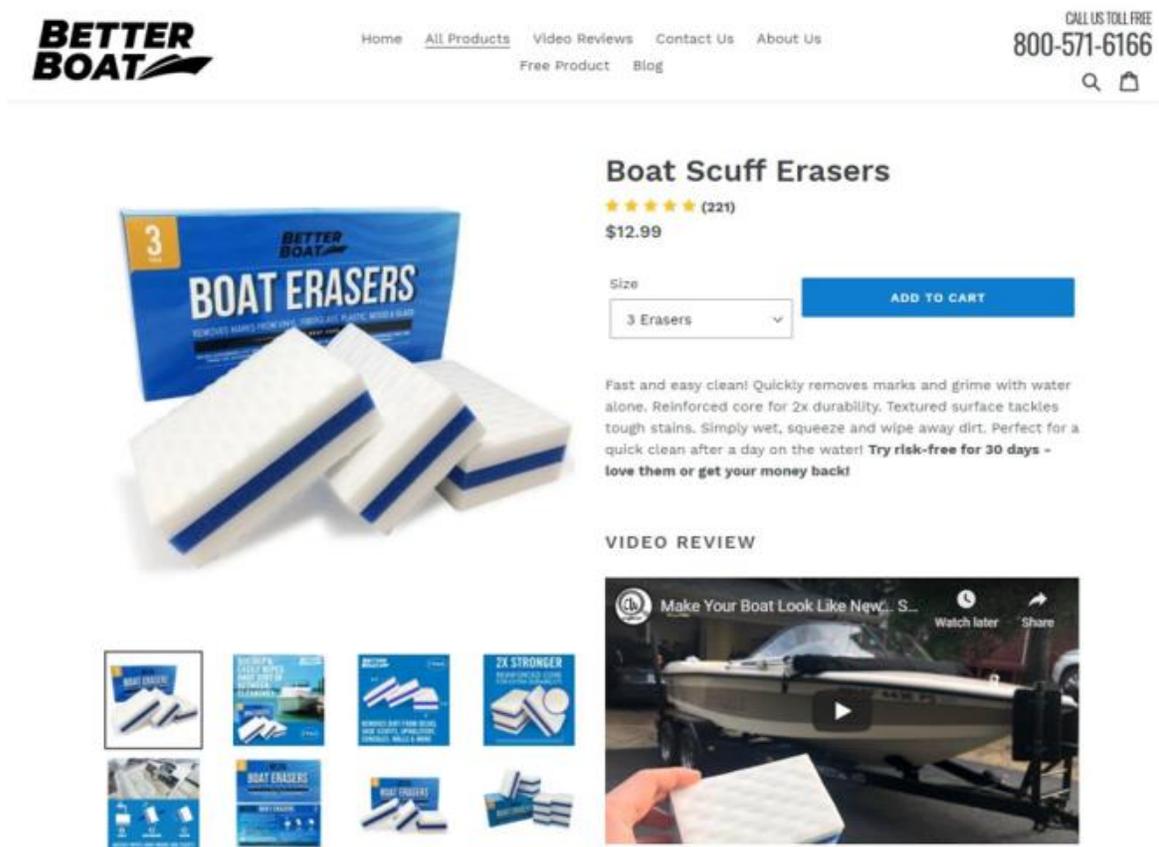
expression. *In re Associated Theatre Clubs Co.*, 9 USPQ2d 1660, 1662 (TTAB 1988) (GROUP SALES BOX OFFICE unregistrable for theater ticket sales services); *In re Phoseon Tech. Inc.*, 103 USPQ2d 1822, 1826 (TTAB 2012) (SEMICONDUCTOR LIGHT MATRIX merely descriptive for light curing systems and UV curing systems). If each component retains its merely descriptive significance in relation to the goods, the combination results in a composite that is itself merely descriptive and unregistrable. *In re Oppedahl & Larson LLP*, 373 F.3d 1171, 71 USPQ2d 1370, 1371 (Fed. Cir. 2004). On the other hand, if, a proposed mark comprising a combination of merely descriptive components creates a unitary phrase with a unique, nondescriptive meaning, or if the composite has an incongruous meaning as applied to the goods, or forms a double entendre, the mark may be registrable. *See In re Colonial Stores Inc.*, 394 F.2d 549, 55 C.C.P.A. 1049, 157 USPQ 382, 385 (CCPA 1968) (SUGAR & SPICE for bakery products); *In re Shutts*, 217 USPQ 363, 364-65 (TTAB 1983) (SNO-RAKE for a snow removal hand tool having a handle with a snow-removing head at one end, the head being of solid uninterrupted construction without prongs”); *see also In re EBS Data Processing*, 212 USPQ 964, 966 (TTAB 1981) (explaining composite versus unitary mark in context of disclaimer requirements).

The Examining Attorney contends that the proposed mark BOAT ERASERS consists of two words that describe “a purpose, characteristic, use, or function of applicant’s goods,” and their combination retains a descriptive meaning.³ According to the Examining Attorney, “[t]he ordinary meaning of ‘ERASER’ is to erase

³ 8 TTABVUE 4-5 (Examining Attorney’s Brief).

something, not just pencil marks but anything, including grime off a BOAT.”⁴ He points to dictionary definitions of the words in the mark,⁵ competitor use of “Boat Scuff Eraser,” Applicant’s own promotional material, and third-party registrations for marks that include the word ERASER(S), wherein the term “connotes ‘removal’ or ‘elimination’ of something.”⁶

Applicant’s multi-page specimen includes the following content:



⁴ 8 TTABVUE 7 (Examining Attorney’s Brief).

⁵ TSDR January 22, 2021 Office Action at 2-24.

⁶ 8 TTABVUE 15 (Examining Attorney’s Brief).

Frequently Bought Together

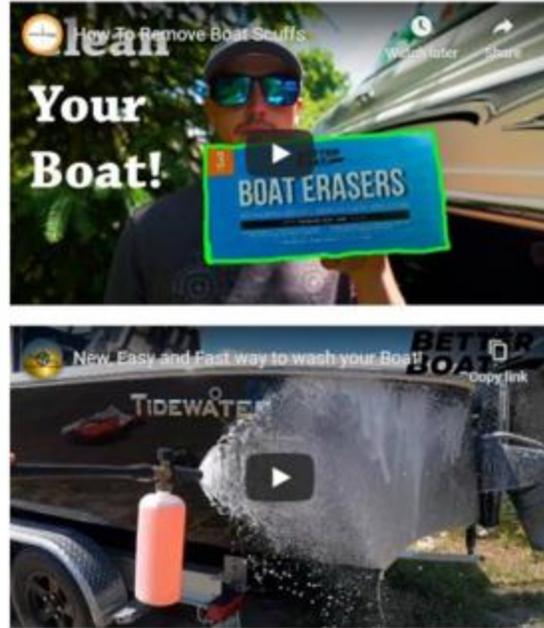


Total price: ~~\$44.97~~ \$40.47

ADD SELECTED TO CART

- This item: Boat Scuff Erasers 3 Erasers \$12.99
- Premium Boat Soap Concentrate \$17.99
- Boat Cleaner Wipes with UV \$13.99

SHARE TWEET PIN IT



extension://bpconcjcammlapcogcnnelfmaeghhagj/edit.html

Notably, next to the “Add to Cart” button, a “Size” pulldown menu appears to the left, with the selection “3 Erasers” showing.

Applicant’s website specimen also features the following customer reviews (arrows added for emphasis):



★★★★☆ **Verified purchase** — 2020/05/31

The erasers worked great on upholstery. However the first eraser out of the box separated immediately. The white outside layer separated from the blue inner layer. I will try some of the other erasers and check with friends that a gave out a couple of boxes and update my post.

Michael W. 



In addition, the third page of Applicant’s specimen includes “Questions & Answers” from its website, including the following (emphasis added):

Question: Will this take the Gelcoat off my Boat?

Answer: Our Erasers are designed to be less abrasive than traditional household ones so you can feel confident using it on your boat. We recommend you wet the **eraser** at first and apply pressure softly to the specific mark rather than cleaning large areas as you would with a soapy sponge.

Question: What’s the difference between these and the regular grocery store option I can get?

Answer: Our Boat Erasers are specifically designed for use on Boats. Our **eraser** is substantially larger and thicker, which means you’ll get the job done faster with less frustration. We have reinforced the core with an added layer to increase durability and lastly, they are less abrasive than **erasers** you use to clean your tub at home. You will be amazed at the difference.

The Examining Attorney also submitted another page from Applicant’s website that touts the identified goods, stating “[t]hese erasers tackle the most impossible

dirt with ease.”⁷ The Amazon.com page for Applicant’s identified goods states, “[o]ur premium boat eraser sponge quickly and effectively remove [sic] dirt, grime, grease, mud, scum, and scuffs from the deck, console and seats of your boat.”⁸ Some customer comments on the Amazon.com page for the identified goods include:

“More heavy duty than the Mr. Clean magic **erasers**, and last longer too.”

“I literally wiped the **eraser** across my boat seat and it was instantly clean.”

“The scuff **eraser** helped me to reconcile these.... Unfortunately, the **eraser** suffered a lot from performing this trick and retired to the waste bin.”

“These **erasers** are so much more durable and better made than the ones you buy at the grocery store.”⁹

Applicant’s own specimen and promotional materials clearly reflect descriptive use of the wording in the proposed mark. We find this type of evidence compelling in support of the descriptiveness of the terms. *See N.C. Lottery*, 123 USPQ2d at 1710 (relying on the applicant’s explanatory text in its specimen as “supplying commercial context” for the descriptiveness inquiry); *In re Empire Tech. Dev. LLC*, 123 USPQ2d 1544, 1549 (TTAB 2017) (“[T]he way an applicant uses an alleged mark (or a component term in a mark), ... in promotional materials or packaging, is relevant to whether consumers will perceive the mark as an indicator of source or instead as descriptive or generic.”).

⁷ TSDR March 9, 2021 Office Action at 9 (emphasis added).

⁸ TSDR January 22, 2021 Office Action at 24-25 (amazon.com).

⁹ TSDR January 22, 2021 Office Action at 31-32 (amazon.com).

In addition to this proof of Applicant's own descriptive use, the Examining Attorney also submitted some relevant third-party use of the terms in the proposed mark. For example, Walmart's website features the Star Brite "Boat Scuff Eraser" for "removing shoe scuff marks on decks."¹⁰ The same Amazon.com page featuring Applicant's goods shows at the bottom third-party similar goods "also viewed" by customers viewing Applicant's goods, including "XL Boat Scuff Erasers," the "Outus 8 Pack Boat Scuff Erasers Boat Sponge," and the "PAMASE 24 Pack Boat Scuff Erasers."¹¹

Based on the foregoing, we disagree with Applicant's characterization that "the Examining Attorney has failed to make of record any evidence that third parties use 'Boat Eraser' descriptively, to describe a product that can be used in cleaning boats."¹² Instead, we find the references to "boat scuff erasers" for the same types of products as Applicant's sufficiently similar in their use of the wording in the subject mark to constitute descriptive use by third parties in the industry.

We reject Applicant's contention that "[l]ongstanding Board policy" provides that the term ERASER cannot be deemed descriptive. The only legal authority Applicant offers for the alleged policy is a 1978 decision by the Court of Customs and Patent Appeals, which explicitly stated that it did "not reach the alternative ground, i.e., that ERASE is merely descriptive." *In re Clorox Co.*, 578 F.3d 305, 198 USPQ 337,

¹⁰ TSDR January 22, 2021 Office Action at 36 (walmart.com).

¹¹ TSDR January 22, 2021 Office Action at 26, 34 (amazon.com).

¹² 6 TTABVUE 3 (Applicant's Brief).

339 n.3 (CCPA 1978). Quite obviously, this does not set forth a policy that the term cannot be considered descriptive, much less any policy.

To the extent Applicant relies on 18 third-party registrations of marks that include ERASE or ERASER, without a disclaimer or claim of acquired distinctiveness,¹³ as evidence of the supposed “Board policy,” we are not persuaded for several reasons. First, we have no indication that the Board decided the registrability of these marks, so their existence does not suggest a Board policy. Second, almost all of the registrations involve different goods, mostly hair or cosmetic products, and some as diverse as windshield wiper blades and medical devices, so they are not analogous to the subject application.¹⁴ Third, the two registrations that identify cleaning preparations still do not involve identical goods – they are not for cleaning sponges but rather for cleaning preparations such as polishes and waxes.¹⁵ They also were registered based on different evidentiary records, and regardless are too few in number to reflect any kind of USPTO “policy.” As Applicant acknowledges in its Brief, “each case must stand on its own merits.”¹⁶ “Thus, even if some [of these] prior registrations had some characteristics similar to ... [the subject] application, the [US]PTO’s allowance of such prior registrations does not bind the Board” *In*

¹³ Registration No. 6247900 is registered on the Supplemental Register, reflecting its treatment as descriptive. *Id.* at 56-58.

¹⁴ TSDR September 9, 2021 Request for Reconsideration at 13-64.

¹⁵ TSDR September 9, 2021 Request for Reconsideration at 13, 37 (Registration Nos. 7148989 and 5831471). The first registration is for “Polishes, waxes and cleaning preparations for use on the surface of vehicles, boats and airplanes” and the other is for “Cleaning preparations for Automobiles, namely, detailing and decontaminating surfaces.”

¹⁶ 6 TTABVUE 8 (Applicant’s Brief).

re Nett Designs, Inc., 236 F.3d 1339, 1342, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). Prior registrations “are not conclusive on the question of descriptiveness ... [e]ach case must stand on its own merits.” *In re theDot Commc’ns Network LLC*, 101 USPQ2d 1062, 1067 (TTAB 2011) (citations omitted).

Considering Applicant’s mark in its entirety, we find that the combination of individually descriptive terms results in a composite that remains merely descriptive, and does not result in a whole that is greater than the sum of its parts. We find no unitariness, incongruity, or double entendre that would render the combined words non-descriptive. Applicant argues that its proposed mark is suggestive, not descriptive, because its products “Do Not Literally Erase Boats.”¹⁷ Applicant maintains that it requires imagination and thought for consumers to understand that its products are cleaning sponges that remove dirt and marks from boats. However, the record clearly shows that such cleaning sponges are commonly referred to by Applicant and others as “erasers” and that they are specially designed and marketed for use on “boats.” We thus find that consumers encountering the term BOAT ERASERS for these types of goods would immediately recognize the term as describing features of the goods and their intended use. In the same way that the public understands that a “chalkboard eraser”¹⁸ or “whiteboard eraser” is for use on

¹⁷ 6 TTABVUE 11 (Applicant’s Brief).

¹⁸ See TSDR January 22, 2021 Office Action at 14 (wordnik.com) (reference to “chalkboard eraser” in one of several definitions of “eraser” as “[a] thing used to erase something written by chalk on a chalkboard”).

those types of surfaces – rather than that they erase those objects – consumers would understand BOAT ERASER as an eraser sponge intended for use on boats.

Decision: We affirm the refusal to register Applicant's proposed mark on the ground that it is merely descriptive.